

Appl. No. 09/943,822
Amdt. dated August 24, 2005
Reply to Office action of June 17, 2005

REMARKS/ARGUMENTS

Applicants have received the Office action dated June 17, 2005, in which the Examiner: 1) rejected claims 1, 2, 4, 6-8, 11-16, 19, 20, 22-24, 27-32 and 35-37 under 35 U.S.C. § 102(e) as being anticipated by Burns (U.S. Pat. No. 6,405,315); 2) rejected claims 3, 5 and 21 under 35 U.S.C. § 103(a) as being obvious over Burns in view of Collins (U.S. Pat. No. 6,378,072); and 3) rejected claims 9, 10, 17, 18, 25, 26, 33 and 34 as being obvious over Burns in view of Downs (U.S. Pat. No. 6,226,618). With this Response, Applicants have amended claims 1, 10, 11, 19, 24, 26-29, and 35-37 and canceled claims 6, 8, 9, 17, 18, 22, 23, 25, 33, and 34. Based on the amendments and arguments contained herein, Applicants believe all pending claims to be in condition for allowance.

The Examiner concluded that Burns is "silent in the use of encrypting the encrypted data...and transmitting the twice encrypted data." For those claims that have such or similar limitations, the Examiner instead turned to Downs at col. 3, lines 42-46. That passage of Downs does not teach or even suggest encrypting data that is already in encrypted form. Instead, that passage of Downs discloses decrypting an encrypted data decrypting key, that was initially encrypted with a public key, and then re-encrypting the data decrypting key with a different public key.

Applicants have amended claim 1 to require "retrieving the encrypted data from the storage device; the storage device encrypting the retrieved encrypted data with a pre-determined key to produce twice encrypted data; and transmitting the twice encrypted data to the computer." This feature is not disclosed in Burns, as readily acknowledged by the Examiner. Further, this feature is not disclosed in Downs as noted above. For at least this reason, claim 1 and all claims are allowable over the cited art.

Appl. No. 09/943,822
Amdt. dated August 24, 2005
Reply to Office action of June 17, 2005

Claim 1 is patentable for another reason as well. The limitations quoted were previously found in claim 9, now canceled. With regard to claim 9, the Examiner concluded that Burns was deficient, but combined the alleged teachings of Downs with Burns to satisfy the deficiency of Burns. Burns has the following teachings:

- "[A]ll data encryption is handled by the clients, rather than the devices, to overcome the above-described security problems." Col. 2, lines 48-51.
- "The storage device themselves do not have any encryption capabilities" Col. 3, lines 19-21.
- "The advantage of this approach is that data is encrypted or decrypted by the clients as opposed to having the encryption being done at both the [storage] devices and the clients." Col. 5, lines 31-34.
- "In the file system of the invention, a network storage device is trusted to store the encrypted file system data..., but it is not trusted to keep the data secret. Only clients in possession of appropriate encryption and decryption keys can read the data and meta-data of the file system." Col. 5, lines 47-52.

These teachings would lead one of ordinary skill in the art to know that Burns is teaching away from having the storage devices performing encryption on the stored encrypted data. Moreover, Burns teaches away from the very limitation that the Examiner believes is disclosed in Downs (which is not disclosed in Downs as explained above). For this additional reason, claim 1 is allowable. Any reference that the Examiner might find to replace Downs would also be problematic in that Burns teaches away from the claimed invention.

Amendments were made to other independent claims in much the same vein as the amendments to claim 1. For the same or similar reasons as those discussed above, the remaining pending claims are patentable as well.

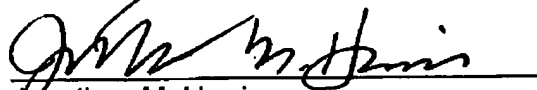
The Examiner used Collins to reject claims 3, 5, and 21. As evidenced in the attached printout of the PTO assignment information web page, Collins was assigned to Compaq Information Technologies Group, L.P. as of the day the

Appl. No. 09/943,822
Amdt. dated August 24, 2005
Reply to Office action of June 17, 2005

present application was filed. The present application was also assigned to Compaq Information Technologies Group, L.P. Because Collins qualifies as prior art only by virtue of 35 U.S.C. § 102(e) and Collins and the present case were, and still are, commonly owned, Collins cannot be used as prior art in an obviousness rejection of any of the present claims. The Examiner concluded that Burns contains a deficiency with regard to the inventions of claims 3, 5, and 21. Because Burns is deficient as conceded by the Examiner and Collins cannot be used as prior art, the obviousness rejections of claims 3, 5, and 21 are without merit.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



Jonathan M. Harris
PTO Reg. No. 44,144
CONLEY ROSE, P.C.
(713) 238-8000 (Phone)
(713) 238-8008 (Fax)
ATTORNEY FOR APPLICANTS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
Legal Dept., M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400